



Geographical Indications and Trademarks in Vietnam: confusion or real difference?

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Abstract – Geographical indications (GIs) in Vietnam are protected through a sui generis system involving a State-driven management following a top-down approach. However, in practice, collective or certification trademarks (TMs) are increasingly used as origin labels, following the same path of a State-driven process. This is mainly explained by the very demanding criteria to meet for proving the qualitative link with the origin in the case of GIs, which may be considered as going beyond the GI definition, and the sometimes arbitrary choice between TM and GIs to meet quotas. Drawing upon case studies, the paper shows that the choice between GIs or TMs is not the most relevant factor to contribute to local economic development, preserve traditional knowledge and conserve biodiversity. The marketing channels seem to be more significant. Yet the lack of consideration of the weaker level of protection of TMs compared to GIs might be a threat. Finally, it seems legitimate to question the EU's preferential policy for GIs over TMs in the bilateral agreement between Vietnam and the EU.

Keywords – Geographical Indications, Trademarks, Vietnam, EU.

INTRODUCTION

Regional branding initiatives are more and more spread as a means for reconnecting agrifood products to places and, by doing so, for creating value in rural areas. Regional branding encompasses several types of initiatives, ranging from very formal ones – such as geographical indications (GIs) protected worldwide since the adoption of the Trade-Related Aspects of Intellectual Property Rights (TRIPs) Agreement of the World Trade Organisation (WTO) in 1995– to umbrella strategies where links between products and place are much weaker.

In Vietnam, regional branding initiatives result from projects funded by public authorities and organisations, with funding and subsidies available from both domestic and international sources. Clearly, the availability of public funding is a demonstration of the increasingly growing interest generated in the country by GIs and TMs using geographical names as a promising tool for 'socio-economic development [...] to eliminate hunger and reduce poverty' and for the preservation of the 'cultural values and traditional knowledge of the nation'.

In Vietnam, the actual legal framework for protecting geographical names designating origin products, remodelled in 2005 with the adoption of the Intellectual Property Law (IP Law) to allow the country's accession to the WTO, confirmed the choice of a sui generis GI system which was first established in 1995 for the protection of appellations of origin

(AOs) (Dao_The, Vu_Trong et al. 2009). A feature of this system is that the registration and management processes are driven by state authorities through a top-down approach leading to 45 registered GIs in 2015 (including 3 foreign GIs). In practice, collective or certification trademarks (TMs) which have also been introduced in 2005 are increasingly used as origin labels, following the same path of a State-driven process, with about 130 collective and 60 certification TMs (May 2013). In practice, GIs and TMs are placed at the same level, without entering the hot debate of conflict between countries with sui generis GI systems and countries with the TMs systems (Josling 2006).

Drawing upon a number of case studies, we will show how the choice between GIs and TMs in Vietnam is often arbitrary, and its consequences at national and international level to contribute to local economic development, preserve traditional knowledge and conserve biodiversity.

METHODS

To answer the question we raised, we analysed legal national texts such as the IP Law and its circulars and decrees as well as other legal sources such as GI specifications and regulations of use of TMs (for a dozen of GIs and a dozen of TMs). We also conducted field work on several cases of GIs and TMs, using interviews with local authorities and stakeholders of the supply chain. Data are also sourced from development projects we have been involved in, funded by international agencies.

THE CHOICE BETWEEN GIS AND TMS?

One of the reasons of the success of TMs versus GIs is the very demanding criteria to meet for proving the qualitative link with the origin in the case of GIs, due to the experience of AOs back to 1995, with the famous Nuoc Mam from Phu Quoc being an AO now protected in the EU since 2012. However, the link between product and place could be less stringent in the case of GIs considering that, according to the IP Law of Vietnam, reputation, as determined on the basis of consumers' trust through the extent to which the GI is known and selected by consumers, is a sufficient criterion for registering GIs. However, in practice, all registered GIs had to demonstrate a quality or characteristics linked to the origin, defined by one or several qualitative, quantitative or physical, chemical, microbiological perceptible norms which shall be testable by technical means or experts with appropriate testing methods (Thomas and Dao 2009).

Moreover, the choice of a particular means of protection in Vietnam may sometimes be done in an arbitrary way with the view to meet the quotas for GIs and TMs attributed to each Province through public policy. For example the Shan tuyết tea from Suối Giàng in the Province of Yên Bái is protected as a certification TM because there was already a GI in the same province (for the cinnamon of Văn Yên), whereas

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the denomination Shan tuyết tea from Moc Chau, in another Province, has been registered as a GI. Such arbitrary character is even more evident when looking at the stakeholders involved in registering GIs and TMs, in a context of State-driven top-down process. By law, the owner of all GIs is the State, and in practice GI applications are filed by the provincial Departments of Science and Technology (DOST) or the People's Committees (PC) of the provinces, districts or cities concerned.

Certification TMs are usually owned by local public authorities (33 out of 36 TMs comprising geographical name as for May 2013) who are in charge of their control. Regarding collective TMs, even if they are owned by a collective organization of producers, such collective has usually been established with the support of a public authority, as it is the case of the collective TM for sticky rice from Đông Triều. Such involvement of local authorities including for TMs is explained by the obligation under IP Law, when TMs are for local specialties of Vietnam, to get the permission of the competent state agency. The confusion is even wider considering that, for GIs, local authorities are in charge, in the post-registration step, to set up the collective organisation responsible for managing the GI by delegation. For instance, in the case of the Fried Calamari from Ha Long GI, both the establishment of the producers association and the nomination of its President were decided by the PC of Ha Long City. Other similarities regard the control schemes which (in theory as no control is effective yet) are provided by the same agency for TMs and GIs: the Directorate for Standards, Metrology and Quality at the Provincial level (STAMEQ).

Yet the National Office of Intellectual Property tries to apply substantive criteria to discriminate between GIs and TMs, with for example the advice to go for a certification TM and not a GI for the milk from Bavi because of lack of a terroir effect.

CONSEQUENCES AT NATIONAL AND INTERNATIONAL LEVEL

Governed in a similar way, with a strong State involvement as in many other Asian countries (Biénabe and Marie-Vivien 2015), the coexistence of GIs and TMs raises questions. At first sight, looking at their contribution to local economic development, preservation of traditional knowledge and conservation of biodiversity, the choice of a legal tool to protect geographical origin does not appear as the most relevant factor. Indeed, it has been shown in another paper that a number of contextual factors related to the actual operation of the initiatives, including the space available for farmers and producers to take ownership of the initiatives, limited financial resources of the control agencies and of the producers' and farmers associations, low awareness and lack of production or management capacities are all decisive determinants that promote or hinder the use of the

label and the success of the initiatives from a socio-economic development perspective (Pick, Marie-Vivien et al. 2015). Looking at the legal protection itself, it is a different story. Indeed, TMs are usually composed of a geographical name combined with a logo, thus not conferring exclusive right on the geographical name contrary to GIs, and TMs are governed by the first to file, first in right principle.

For example, in the case of the certification TM Moc Chau vegetables, little awareness of the legal differences between GIs and TMs led to a dispute with the owner of a previous TM comprising the name Moc Chau also for vegetables. At the international level, we question the appropriateness of the EU's preferential policy for GIs protection over TMs in the newly signed Protocol to the Framework Agreement on Comprehensive Partnership and Cooperation between Vietnam and the EU.

According to this Protocol, only Vietnamese GIs will be legally recognised in the EU but none of the Vietnamese TMs, as the EU does not consider TMs comprising geographical name as GIs, especially in a country which provides for a GI sui generis system. However, in light of the high number of TMs for origin products complying with the criteria of reputation provided by GI definition in Vietnam and worldwide (PGI in the EU), it would have seemed appropriate for the EU to ask Vietnam to convert those complying and eligible certification and collective TMs into GIs, hereby enlarging the number of EU GIs included in the Agreement... a win-win process.

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